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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,542	04/07/2001	Shane A. Bryan	10001140811	5682

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EXAMINER

WALLERSON, MARK E

ART UNIT PAPER NUMBER

2626

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,542

Applicant(s)

BRYAN ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,6-20,22,23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,6-20,22,23 and 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Part III DETAILED ACTION

Notice to Applicant(s)

1. This action is responsive to the following communications: Amendment filed on 3/9/2005.
2. This application has been reconsidered. Claims 1, 6-20, 22, 23, and 25-34 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6-20, 22, 23, and 25-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al (Ferrel) (U.S. 5,860,073) in view of Park (U.S. 5,717,974).

With respect to claims 1, 8, 9, 11, 12, 16, 27, and 34, Ferrel discloses receiving information from a producer to update a publication profile (column 9, lines 28-36); selecting content objects received from content providers based on the publication profile (column 8, line 56 to column 9, line 36), and generating a publication utilizing a subset of the objects (column 8, line 56 to column 9, line 62).

Ferrel differs from claims 1, 8, 12, and 27 in that although he discloses inserting advertisements on the publications (column 16, lines 9-13, column 18, lines 11-26 and column

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20, lines 43-50), he does not clearly disclose initiating delivery of a product subsidy when the user has printed a predetermined number of publications.

Park discloses a means for replacing consumable in a printer based on the number of sheets that have been printed (the abstract and column 3, lines 50-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ferrel to initiate delivery of a product subsidy when the user has printed a predetermined number of publications. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ferrel by the teaching of Park in order to ensure continuous high quality printing as disclosed by Park in column 1, lines 23-24).

With respect to claims 13, 14, 15, 16, 18, 19, 20, 22, 23, 26, 28, 29, 30, 31, 32, and 33, Ferrel discloses editing the publication (column 3, lines 54-67 and column 10, lines 29-47).

With respect to claims 6 and 7, Ferrel discloses distributing the publication to subscribers (customers) (column 9, line 63 to column 4, line 10) and initiating a financial transaction (column 11, lines 61-67).

With respect to claim 10, Ferrel discloses the content objects are selected on a periodic basis (column 9, lines 28-36).

With respect to claim 17, Ferrel discloses the producer is software agent executing on a remote system (figure 1).

With regard to claim 25, Ferrel discloses plural publications (column 9, lines 10-27).

Response to Arguments

5. Applicant's arguments filed 3/9/2005 have been fully considered but they are not persuasive. Applicant submits that Park does not disclose initiating delivery of a product subsidy when the user has a predetermined number of copies. The Examiner disagrees.

Park discloses initiating delivery of a product subsidy when the user has a predetermined number of copies (which reads on printing a report that indicates that replaceable parts within the printer should be replaced after a number of prints have been made) (column 3, lines 12-25).

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Park informs the user when certain replaceable parts within the printer (such as the toner receptacle) have reached a predetermined threshold (after a number of copies have

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been made). This ensures continuous high quality printing in the image forming apparatus (column 1, lines 22-34 and column 3, lines 4-25).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

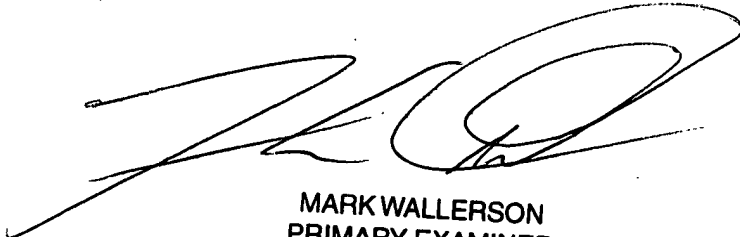
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER